

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 3-9, 11-20 are pending in the application, with claims 1, 9, and 17 being the independent claims. Claims 18-20 are sought to be added. Claims 1, 9, and 17 are sought to be amended. Support for the amendments and the new claims is found, for example, in paragraphs [0014], [0019], [0020], and [0021] of the originally filed specification. Applicant reserves the right to prosecute similar or broader claims, with respect to the amended and canceled claims, in the future. These changes introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Statement of Substance of Interview***

The Examiner is thanked for his time during a telephonic interview with Applicant's representative Ed Yee on November 15, 2007. It appeared that the Examiner had agreed to enter an Examiner's Amendment regarding claims 1, 9, and 17 and that a Notice of Allowance would be forthcoming.

Applicant respectfully requests that the Examiner send an Interview Summary of the above-mentioned interview.

***Rejection under 35 U.S.C. § 112***

Claims 1, 9, and 17 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection.

Although Applicant believes that the claims as previously presented comply with this section of the statute, Applicant has amended claims 1, 9, and 17 in order to clarify the claims. Support for the amendments can be found, for example, at paragraphs [0014], [0019], [0020], and [0021] of the originally filed specification. Based on the amendments above, Applicant believes that the rejections have been overcome.

***Rejections under 35 U.S.C. § 102***

Claims 1-17 were rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Jung, U.S. Patent No. 6,566,717 (Jung). Applicant respectfully traverses this rejection.

Claim 1 recites features that distinguish over Jung. For example, claim 1 recites “wherein the ESD protection system is connected in series between the pad and the n-type transistor, and substantially eliminates ESD from flowing from the pad into the n-type transistor, and the size of the n-type transistor and the size of the ESD protection system collectively are less than the size of a single n-type transistor adapted to comply with both the operational requirement and the ESD requirement.” Jung does not teach or suggest such a feature.

The Examiner states that “Jung discloses a system (figure 2) comprises a circuit (220) comprising an n type, the n type transistor adapted to comply with an operational requirement Note that the internal circuit 220, see figure 2, includes a plurality of MOS transistors which is inherently includes an n type of transistor, see col. 6, lines 28-30), an ESD protection system (230) adapted to comply with an ESD requirement, and a pad (210), wherein the ESD protection system is connected in series between the pad and the n type transistor and substantially eliminates ESD from flowing from the pad into the n type transistor (see col. 3, 4, lines 49-5), the size of the n-type transistor and the ESD protection system collectively is less than a size of an n type transistor adapted to comply with the operational and ESD requirements (inherently).” (Office Action, p. 3-4). Applicant respectfully disagrees with this understanding.

Jung does not teach or suggest the above-recited distinguishing feature of claim 1. In the response to the Office Action of May 30, 2007, Applicant detailed differences that exist between Jung’s invention and Applicant’s invention. For example, Jung’s invention is designed to “reduce the complexity of the manufacturing process, and prohibit the ESD characteristic deterioration.” (Jung, col. 4, lines 3-5). Further, Jung’s “disclosed devices decrease processing time and cost by eliminating a silicide protection or a silicide blocking which is needed in the prior art ESD protection circuit manufactured via conventional silicide processing.” (Jung, col. 4, line 65 – col. 5, line 1). In fact, Jung never discusses the dimensions of the ESD protection circuit embodiments he describes. Even assuming that this interpretation of Jung is correct, Jung does not teach or suggest the above recited feature of claim 1 that “the size of the n-type transistor and the size of the ESD protection system collectively are less than the

size of a single n-type transistor adapted to comply with both the operational requirement and the ESD requirement.”

The Examiner also states that “one of ordinary skill in the art would recognize that the size of the n-type transistor (such as a size of an n type of transistor of the internal circuit 220) and the ESD protection system (such as a size of the ESD system 230) inherently is less than a size of any n type transistor in the semiconductor device which is adapted to comply with the operational requirement and the ESD requirement.” (Office Action, p. 2). Applicant respectfully disagrees with the Examiner’s statement.

Applicant asserts that the Examiner has not met the burden of showing inherency of the above-recited feature within Jung. To establish inherency, “the extrinsic evidence ‘must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999) (emphasis added). Further, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP §2112 for further discussion.

Moreover, it is counterintuitive to expect that the overall size of two transistors would be less than the size of a single transistor that performs the same functions as the two transistors.

Thus, in view of the Examiner's mere statement that the feature is inherent, Applicant submits that the Examiner has not met the legal requirements for establishing inherent anticipation. The Examiner has not provided "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows" from the teachings of Jung.

For at least these reasons, claim 1 is patentable over Jung. Claims 3-8 depend from claim 1. For at least these reasons, and further in view of their own features, dependent claims 3-8 are patentable over Jung.

Claims 9 and 17 also recite features which distinguish over Jung. For example, claim 9 recites "wherein the size of the n-type transistor and the size of the means for protecting the circuit collectively are less than the size of a single n-type transistor adapted to comply with both the operational requirement and the ESD requirement." Claim 17 recites "wherein the one of the NMOS transistor and the PMOS transistor is connected in series between the pad and the n-type transistor, and substantially eliminates ESD from flowing from the pad into the n-type transistor, and the size of the n-type transistor and the size of the one of the NMOS transistor and the PMOS transistor collectively are less than the size of a single n-type transistor adapted to comply with both the operational requirement and the ESD requirement." As discussed above, with respect to claim 1, these features are not anticipated by Jung.

For at least these reasons, claims 9 and 17 are patentable over Jung. Claims 11-16 depend from claim 9. For at least these reasons, and further in view of their own features, claims 11-16 are patentable over Jung.

Reconsideration and withdrawal of the rejections are respectfully requested.

*New Claims 18-20*

New claim 18 depends from claim 1. New claim 19 depends from claim 9. New claim 20 depends from claim 17. For at least these reasons, and further in view of their own features, Applicant respectfully requests that the Examiner pass these claims to allowance.

***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Edward W. Yee  
Attorney for Applicant  
Registration No. 47,294

Date: FEB . 26 , 2008

1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600